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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,645	08/19/2003	Thomas Rathschlag	MERCK-2733	3760
23599	7590	06/29/2005	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			SPEER, TIMOTHY M	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,645

Applicant(s)

RATHSCHLAG, THOMAS

Examiner

Timothy M. Speer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Election/Restrictions

2. Applicant's election with traverse of Group I in the reply filed on 04-19-2005 is acknowledged. The traversal is on the ground(s) that the Office has failed to demonstrate an undue burden to search the claimed inventions. This is not found persuasive because the inventions have been shown to be separately classified and a search of one invention does not entail a search of the others. Such a search is unduly burdensome. Accordingly, claims 15-20 are withdrawn from consideration.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6, 9, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "based on a silicate" (claim 6) and "based on mica" (claim 9) are unclear, rendering these claims indefinite. It is unclear what materials fall within the scope of the phrases at issue. That is, it is not clear how to determine when a material is "based on" either a silicate or mica.

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The phrase "chemically durable" (claim 11), is an undefined relative term, rendering this claim indefinite.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 3, 5, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang (USPN 4,756,951).

Wang discloses a print product comprising a substrate, a layer of printing ink, a primer layer including platelet-shaped particles and a top layer of an overprint varnish (PVC plastisol) (Figure 3 and accompanying text; and col. 4, lines 12-15, 43, & 43-59). Regarding claim 3, Wang teaches that the particles may have a thickness in the range of 5-50 microns and a thickness of 0.06-0.09 microns (col. 6, lines 21-26). These ranges have endpoints within the ranges recited in instant claim 3 and, accordingly, Wang anticipates claim 3. Therefore, instant claims 1, 2, 3, 5 and 12 are considered to be anticipated by Wang.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 6-10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang.

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Wang was discussed above.

Regarding claims 4, 6, 7, 9 and 13, Wang teaches that the disclosed platelet shaped particles may be chosen from a group including mica (col. 5, line 11). Therefore, it would have been obvious to one having ordinary skill in the art to employ mica as the particles in the article of Wang, since Wang suggests mica particles. With respect to claim 6, it is the Examiner's position that since mica is a silicate, the mica particles suggested by Wang are within the scope of the phrase "based on a silicate," as employed in claim 6.

With respect to claim 8 and 10, Wang teaches that the article may include layers in addition to those illustrated, for example, in figure 3, and that such layers may additionally include platelet shaped particles (col. 4, lines 50-59). Therefore, it would have been obvious to one having ordinary skill in the art to include platelet shaped materials in one or more of the layers disclosed by Wang. The Examiner notes that the present claims do not require the "varnish" layer to be an outermost layer, since the present claims employ open transitional language, i.e., "comprising."

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Speer whose telephone number is 571-272-8385. The examiner can normally be reached on M-Th, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Timothy M. Speer


RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774 6/27/05